

REMARKS

The Applicants respectfully request reconsideration of the application in view of the remarks made herein.

Formal Matters

Claims 1 and 6 have been amended to specify "wherein each of said printheads comprises a nozzle plate". Support for these amendments can be found throughout the specification, see, e.g., page 20, paragraph [0048] and page 26, paragraphs [0064].

Claims 1, 6 and 24 have been amended to specify "said second printhead assembly". Support for these amendments can be found throughout the specification, see, e.g., pages 3-5, paragraphs [0007]-[0011] and pages 22-27, paragraphs [0056]-[0065].

Claim 8 has been amended to specify "wherein said printhead-related data is provided from electronic media associated with said second printhead assembly". Support for this amendment can be found in the claims as originally filed, e.g., Claim 8 and throughout the specification, see, e.g., page 5, paragraph [0011].

Claim 22 has been amended to specify "said printhead assemblies". Support for this amendment can be found throughout the specification, see, e.g., pages 3-5, paragraphs [0007]-[0011] and pages 22-27, paragraphs [0056]-[0065].

Claim 27 remains cancelled without prejudice.

As the above amendments introduce no new matter, entry of these amendments by the Examiner is respectfully requested.

Claim Rejections – 35 USC §112-First Paragraph, Written Description

Claims 1-10, 12-17 and 21-26 are rejected under 35 U.S.C. §112, first paragraph for allegedly failing to satisfy the written description requirement. The

Examiner asserts that the claims allegedly contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention and that the claims are allegedly directed to new matter.

In making the rejection, the Examiner asserts that the limitation of "one or more nozzle plates" as recited in Claims 1 and 6, is unsupported by the specification. Specifically, the Examiner asserts that only the terminology of "nozzle orifice plate" is supported by the specification and that the disclosure only supports "'type of nozzle orifice plate' which is singular" and not "one or more nozzle plates". As such, the Examiner suggests that the Applicants "should amend the claim such that the terminology of the claim is consistent with the specification".

Solely to expedite prosecution and without agreeing to the correctness of this rejection, Applicants have amended Claims 1 and 6 as suggested by the Examiner to recite a singular "nozzle plate".

With respect to the suggestion by the Examiner to amend Claims 1 and 6 to recite "nozzle orifice plate" for consistency with the specification, Applicants submit that the term "nozzle plate" is supported by the specification. Indeed, the specification discloses "type of nozzle plate" at page 20, paragraph [0048] and at page 26, paragraph [0064]. Therefore, Applicants submit that the term "nozzle plate" is adequately supported by the specification.

With regard to Claim 8, the Examiner asserts that the limitation of "wherein said printhead assembly comprises electronic media" is unsupported by the specification. Specifically, the Examiner asserts that "files are not equivalent to electronic media" and that Applicants' citation for support "fails to disclose where the files are provided (located)". As such, the Examiner asserts that since "the location of such files is not disclosed as being within the structure of the printhead

assemblies", the Examiner maintains the position that the claim is directed to new matter.

The Applicants respectfully disagree with the assertions of the Examiner and submit that the specification (in particular, at page 5, paragraph [0011]) fully discloses electronic media as being a part of the printhead assembly. Paragraph [0011] from the specification has been reproduced below for convenience:

[0011] This change may be effected in any of a number of ways. For example, memory files and programming module(s) may be provided to enable simple plug-and-play operability in reconfiguring the system for use. In which case, the printer cartridge or other associated hardware to be changed may be set into a standard socket (possibly the printhead holder) that collects the data required from electronic media associated with a printhead or a printhead assembly when plugged into the subject system. The data may alternately be introduced by way of a PCI or USB interface, a CD or DVD containing the relevant data, via Bluetooth wireless or other by reading another electronic media. Still further, relevant data or criteria may be directly entered by a user ... in response to prompts from a user interface such as provided in connection with a display of a general purpose computer or a touch screen monitor, or otherwise.

As described in paragraph [0011] of the specification, the printer hardware "collects the data required from electronic media associated with a printhead or a printhead assembly when plugged into the subject system". Since the printer hardware collects data from electronic media associated with the printhead assembly when the printhead assembly is plugged into the system, the printhead assembly clearly comprises electronic media and the electronic media is located on the printhead assembly. In further support of the electronic media being located on the printhead assembly, Applicants point out that paragraph [0011] further discloses alternatives to "electronic media associated with a printhead or a printhead assembly". Specifically, after describing "associated" electronic media, paragraph

[0011] goes on to state that “[t]he data may alternately be introduced by way of a PCI or USB interface, a CD or DVD containing the relevant data, via Bluetooth wireless or other by reading another electronic media”. As such, Applicants contend that the specification fully supports a printhead assembly which comprises electronic media.

In alleging that the claimed invention is directed to new matter, the Examiner asserts that “[t]he standard for applicant's disclosure is not what one of ordinary skill would recognize”, but “[a]pplicant is only entitled to claim that which is disclosed in applicant's specification”.

The Applicants respectfully disagree. Contrary to the assertions of the Examiner, Applicants submit that in order to satisfy the definiteness and written description requirements, the specification must describe the claimed invention in sufficient detail that one possessing ordinary skill in the art would recognize that the inventor had possession of the claimed invention at the time the invention was made.

Indeed, MPEP 2163 explicitly states:

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116.

Moreover, with regard to definiteness, MPEP 2173.02 states:

The essential inquiry pertaining to the definiteness requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

As such, based on the Applicants' description, and in particular paragraph [0011], Applicants contend that one of ordinary skill in the art would recognize that electronic media associated with a printhead assembly (e.g., to enable "plug-and-play operability") is located on the printhead assembly (i.e., the printhead assembly comprises the electronic media).

However, solely to expedite prosecution and without agreeing to the correctness of this rejection, Applicants have amended claims 8 to recite "wherein said printhead-related data is provided from electronic media associated with said second printhead assembly". This claim language mirrors that in paragraph [0011] as well as the language presented in Claim 8 as originally filed and thus cannot be considered new matter.

Moreover, as discussed above, Applicants submit that this claim language is definite in that one of skill in the art would recognize that electronic media associated with a printhead assembly is located on the printhead assembly (e.g., as described in paragraph [0011]).

Therefore, Applicants submit that all of the claims recite subject matter which is fully supported and described by the present disclosure. Applicants submit that the claimed invention satisfies the written description requirement and thus is not drawn to new matter. Withdrawal of this rejection is thus respectfully requested.

Claim Rejections – 35 USC §112, Second Paragraph

Claims 1, 6, 8, 22 and 24 are rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserts that "[e]ach of the claims recites 'nozzle plates' and/or 'said printhead assembly'".

Solely to expedite prosecution and without agreeing to the correctness of the rejection, Claims 1, 6, 8 and 24 have been amended to recite "said second printhead assembly". Claim 22 has been amended to recite "said printhead assemblies".

Moreover, as discussed above, Applicants have amended Claims 1 and 6 to recite a singular "nozzle plate" as suggested by the Examiner.

In view of the amendments to the claims and the remarks made above, Applicants submit that Claims 1, 6, 8, 22 and 24 are sufficiently clear and are not indefinite and respectfully request withdrawal of this rejection.

CONCLUSION

In view of the amendments and remarks above, Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Office finds that a telephone conference would expedite the prosecution of this application, please telephone Ping Hwang at (408) 553-3738.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10030938-1.

Respectfully submitted,

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By: /David C. Scherer, Reg. No. 56,993/
David C. Scherer, Ph.D.
Registration No. 56,993

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-05991

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